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10/772,196	02/04/2004	Michael L. Jordan	050704/305124	4228

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EXAMINER	
PORTER, RACHEL L	
ART UNIT	PAPER NUMBER
3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/772,196	JORDAN, MICHAEL L.	
	Examiner	Art Unit	
	RACHEL L. PORTER	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 January 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-6 and 9-17* is/are pending in the application.

4a) Of the above claim(s) *10-17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-6 and 9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. The communication is in response to the amendment filed 1/4/10. Claims 1, 3-6, 9 -17 are pending. Claims 10-17 have been withdrawn from consideration.

Information Disclosure Statement

2. The IDS submitted 3/18/2010 has been entered and considered.

Claim Rejections - 35 USC § 101

3. The rejection of claims 1, 3-6 and 9 under 35 U.S.C. 101 as being directed to non-statutory subject matter is hereby withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1,3-6 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is noted that the applicant has amended the language of claims 1 and 9. However, the amendments do not overcome the rejections of record and raise additional issues.

Claim 1 has been amended to recite that" wherein in response to the determination revealing that the at least one prescriptions is fillable in a non-automated manner, selecting a second subset of said workstations to ***semi-automatically*** or manually fill the at least one prescription, said second subset of said workstations that-includes the pharmacist review workstation."

The use of the term "non-automated" to refer to include semi-automatic as well as manual processing is unclear and confusing. The amendments to the claim language do not clarify the extent to which the prescription filling process is "automated" or "non-automated" in independent claim 1 and in the additional dependent claims. Perhaps a clearer distinction is determining whether the orders may be filled in a fully automated manner or not (e.g. whether pharmacist or technician intervention is required).

Moreover, it is still not clear whether the filling of the prescriptions (either with human intervention or in a fully automated manner) is actually a part of claimed invention in claim 1. In particular, the step in either branch is not positively recited. The claim recites "determining ...a set of work stations based for each prescription..;" and "selecting a first subset of said workstations ..." OR "selecting a second subset of said workstations..." If applicant considers "filling the prescription" to lie within the scope of the invention, it is not clear which steps/ details are considered "filling the prescription" (as distinct from "evaluating the queue of orders..."; "selecting the appropriate end user container..." (claim 3); "routing the carrier from a dispensing workstation..." (claim 4)).

5. Claim 1 recites the limitation " the at least one prescription" in lines 11-12. There is insufficient antecedent basis for this limitation in the claim. Applicant alternates between: "one or more prescriptions", "at least one of the prescriptions" and the at least one prescription."

Claims 3-6 inherit the deficiencies of claim 1 through dependency, and are also rejected.

Regarding claim 9, similar analyses may be applied as those used to reject claims 1, and 3-6.

Election/Restrictions

6. Newly submitted claims 10-17 are directed to an invention that is independent or distinct from the invention originally claimed for the reasons provided in the Final Rejection mailed 2/5/09.

7. Applicant's reply/amendment filed on 6/5/09 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3-6, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Lasher et al (US 5,771,657).

[claim 9] Lasher discloses a method of operating a prescription filling line, comprising:

- evaluating a queue of orders to determine whether one or more within each order is fillable in an automated manner or a non-automated manner; (col. 3, lines 32-59)
- selecting an appropriate sized end user container; (Figures 1-2; col. 4, lines 32-53)
- printing and applying a label to said container; (col. 4, lines 5-67)
- inserting the labeled container into a carrier; (Col. 4, lines 5-15, 54-67; col. 5, lines 13-26)
- routing the carrier to a prescription filling station; (Figure 2, col. 6, lines 6-46)
- routing the carrier to an imaging workstation; and (Col. 8,lines 23-26; figure 9--An RFID tag reader (imaging workstation)verifies that the correct carriers are in place on the turntable.)

- wherein in response to the determination revealing that at least one of the prescriptions is fillable in an automated manner, the method further comprises selecting a first subset of automated equipment to fill the at least one prescription entirely automatically, said first subset excludes a pharmacist review workstation for reviewing a respective filled order by a pharmacist, and col. 10, lines 50-55; col. 12, lines 52-col. 13, line 3: (without pharmacist review/ workstation)
- wherein in response to the determination revealing that at least one prescription is fillable in a non-automated manner, the method further comprises selecting a second subset of said equipment to semi-automatically or manually fill the at least one prescription, said second subset of said equipment includes the pharmacist review workstation. (col. 3, lines 32-59; col. 10, lines 52-60; col. 13, lines 19-47—prescriptions that cannot be filled in an automated manner are diverted to pharmacist station for manual filling and review)
- wherein when said order has been filled by the automated equipment, routing each carrier for said order to a packing workstation without a review by a pharmacist, and (col. 10, lines 50-55; col. 12, lines 52-col. 13, line 3: completed orders with no barcode, crossover or imaging discrepancies are shipped out without pharmacist review)
- wherein when said order has at least one prescription filled by the non-automated equipment, routing each carrier for said order to a pharmacist workstation before routing each carrier to the packing workstation. (col. 13, lines 19-47)

Claim 9 has been amended to recite "determining via a control computer." Lasher discloses that the PAC (i.e. controller computer) determines prescription can be filled automatically or manually. (col. 3, lines 60-66) The system has a manual dispense or an Auto-Pack mode, and a marriage production order (i.e. for shipping orders with multiple types for prescriptions)

[claim 1] Lasher discloses a method of discriminating between orders, comprising:

- evaluating a queue of orders to determine whether one or more prescriptions within each order is fillable in an automated manner or a non- automated manner; and (col. 3, lines 32-59)
- determining a set of workstations for each prescription based on said evaluating, (col. 3, lines 32-59; col. 10, lines 52-60; col. 13, lines 19-47)
- wherein in response to the determination revealing that at least one of the prescriptions is fillable in an automated manner, the method further comprises selecting a first subset of said of workstations to fill the at least one prescription entirely automatically, said first subset of said workstations excludes a pharmacist review workstation for reviewing a respective filled order by a pharmacist and, and (col. 10, lines 50-55; col. 12, lines 52-col. 13, line 3: (without pharmacist review/ workstation)
- wherein in response to the determination revealing that at least one prescription is fillable in a non-automated manner, the method further comprises selecting a second subset of said workstations to semi-automatically or manually fill the at

least one prescription, said second subset of said workstations includes the pharmacist review. (col. 13, lines 19-47—manually dispensed and/or packaged; col. 3, lines 32-59; col. 10, lines 52-60; col. 13, lines 19-47—prescriptions that cannot be filled in an automated manner are diverted to pharmacist station for manual filling and review)

Claim 1 has been amended to recite "determining via a control computer." Lasher discloses that the PAC (i.e. controller computer) determines prescription can be filled automatically or manually. (col. 3, lines 60-66) The system has a manual dispense or an Auto-Pack mode, and a marriage production order (i.e. for shipping orders with multiple types for prescriptions)

[claim 3] Lasher discloses the method of claim 1 additionally comprising selecting an appropriate sized end user container (Figures 1-2; col. 4, lines 32-53), printing and applying a label to said container (col. 4, lines 5-67), inserting the labeled container into a carrier (Col. 4, lines 5-15, 54-67; col. 5, lines 13-26) and routing the carrier among the first or second subset of workstations. (Figure 2, col. 6, lines 6-46)

[claim 4] Lasher discloses the method of claim 3 wherein said routing includes routing the carrier from a dispensing workstation (Figure 2, col. 6, lines 6-46); to an imaging workstation (Col. 8,lines 23-26; figure 9--An RFID tag reader (imaging workstation) verifies that the correct carriers are in place on the turntable.) and to a capping workstation. (col. 8, lines 1-11)

[claim 5] Lasher discloses the method of claim 4 additionally comprising tracking multiple prescriptions that belong to one order and grouping all the prescriptions that belong to one order for shipping. (col. 10, lines 61-col. 11, lines 6; col. 12, lines 52-col. 13, line 10)

[claim 6] Lasher discloses the method of claim 4 additionally comprising routing the carrier to a packing workstation where a patient specific document is printed and inserted into a labeled bag along with the patient's prescription. (col. 9, lines 1-31)

Response to Arguments

10. Applicant's arguments filed 1/4/2010 have been fully considered but they are not persuasive.

(A) Applicant argues that the newly added limitations and features. The Examiner has provided additional citations from the reference to address the newly added features.

(B) Applicant argues that the claims have been amended to overcome the rejection under 35 USC 112, 2nd paragraph.

It is noted that the claim language has been amended. However, the use of the term “non-automated“ to refer to include semi-automatic as well as manual processing is unclear and confusing. The amendments to the claim language do not clarify the extent to which the prescription filling process is "automated" or “non-automated” in independent claim 1 and in the additional dependent claims. Perhaps a clearer

distinction is determining whether the orders may be filled in a fully automated manner or not (e.g. whether pharmacist or technician intervention is required).

Moreover, it is still not clear whether the filling of the prescriptions (either with human intervention or in a fully automated manner) is actually a part of claimed invention in claim 1. In particular, the step in either branch is not positively recited. The claim recites "determining ...a set of work stations based for each prescription..;" and "selecting a first subset of said workstations ..." OR "selecting a second subset of said workstations..." If applicant considers "filling the prescription" to lie within the scope of the invention, it is not clear which steps/ details are considered "filling the prescription" (as distinct from "evaluating the queue of orders..."; "selecting the appropriate end user container..." (claim 3); "routing the carrier from a dispensing workstation..." (claim 4)). As such, the 112, 2nd paragraph rejections have been maintained.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Helmus et al (US 20090164244 A1) and Mahar (US 20040260424A1) .

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL L. PORTER whose telephone number is (571)272-6775. The examiner can normally be reached on M-F, 10-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L. P./
Examiner, Art Unit 3626

/C. Luke Gilligan/
Primary Examiner, Art Unit 3626